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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/895,347

06/29/2001

Regis J. Crinon

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06/16/2006

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EXAMINER

TRAN, HAI V

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/895,347

**Applicant(s)**

CRINON ET AL.

**Examiner**

Hai Tran

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 10/31/2005 have been fully considered but they are not persuasive.

Amended Claims 1, 8, 18, 22, 29 and 39 still do not overcome the rejections under 35U.S.C. §101 as being directed to non-statutory matter. Also, in regard to Applicant's remark toward the independent claims 15 and 36 that "limitations recited in each of the claims arrive at a tangible result" is not persuasive because Applicant does not provide any explanations on how/why they are NOT directed to non-statutory subject matter.

The Examiner asserts that method claim 15 merely manipulates an Abstract Idea of using an algorithm and therefore has no practical application that produces a useful, tangible and concrete result.

As to claim 36, the claimed "machine accessible medium providing instructions..." is non-statutory because

a) limitation "machine accessible medium" is NOT a computer component, i.e., "computer-readable medium".

b) the "machine accessible medium providing instructions..." does not define any structural and functional interrelationships between the computer program (instructions) and other claimed element of a computer, i.e., computer-readable medium (notes: "machine accessible medium" is NOT claimed as "computer-readable medium") which permit the computer program's functionality to be realized.

c) the "machine accessible medium providing instructions" for performing the same method as in claim 15 merely provides instructions for manipulating an Abstract Idea in fulfilling the algorithmic steps and therefore has no practical application that produces a useful, tangible and concrete result.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-42 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

According to the disclosure, the method claims 1-21 are directed toward a method of determining a metric of a carousel, i.e., a number. The claimed language does not arrive at a tangible result and the claimed "metric" (number) has no practical application that produces a useful, tangible and concrete result. The method claims 1-21 merely manipulates an Abstract Idea of using either a mathematical formula or an algorithm and therefore have no practical application. Furthermore, the method in claims 1-14 further seeks patent protection for a formula in the abstract; therefore, are not patentable; see Diehr, 450 U.S. at 191, 209 USPQ

at 10. *“Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”* Benson, 409 U.S. at 67, 175 USPQ at 675. *One may not patent a process that comprises every “substantial practical application” of an abstract idea, because such a patent “in practical effect would be a patent on the [abstract idea] itself.”* Benson, 409 U.S. at 71-72, 175 USPQ at 676; cf, Diehr, 450 U.S. at 187, 209 USPQ at 8.

As to claims 22-42, the article of manufacture claims 22-42 directed toward a “machine accessible medium” for determining the goodness metric of a carousel do not arrive at a tangible result and are simply steps taken for working through an algorithm on a “machine accessible medium”. This “machine accessible medium” could be as broad as a scanner, for interpreting a printed medium that provides instructions for fulfilling the algorithmic steps, as claimed.

The “machine accessible medium” of claim 22 for performing the same method as in claim 1 merely manipulates an Abstract Idea of using a mathematical formula for determining a “metric” (number), which has no practical application that produces a useful, tangible and concrete result.

Moreover, recited limitation “machine accessible medium” in claims 22-42 is NOT a computer component, i.e., “computer-readable medium”; therefore, claims 22-42 are thus non-statutory. The claimed “machine accessible medium providing instructions...” is further non-statutory because the “machine accessible medium

providing instructions..." does not define any structural and functional interrelationships between the computer program (instructions) and other claimed element of a computer, i.e., computer-readable medium, which permit the computer program's functionality to be realized. *In contrast, a computer readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of computer which permit the computer program's functionality to be realized, and is thus statutory.* See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

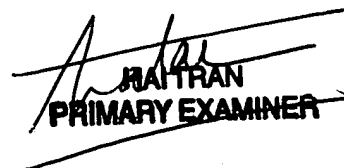
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht  
06/01/2006

  
HAI TRAN  
PRIMARY EXAMINER